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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Eugene Vogt

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09/30/2002

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 09/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,682

Applicant(s)

VOGT, ROBERT EUGENE

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001 and 13 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention: the species of Figures 1-3 and the species of Figures 4-5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-5 and 8-12 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Applicant's election of the species of Figures 1-3 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 6-7 and 13-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 4.

The restriction requirement discussed with the Applicant on September 10, 2002 has been withdrawn due to the cancellation of claims and amendment of claims in the preliminary amendment. Claims 6 and 13 also do not read on the elected species, see page 9, paragraph beginning at line 28.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

5. The abstract of the disclosure is objected to because the legal terminology, i.e. "comprising", should be avoided. The abstract is too long, i.e. no more than 150 words. Correction is required. See MPEP § 608.01(b).

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6. The drawings are objected to because Figures 2 and 5 are inconsistent with the description thereof on page 8, i.e. in Figure 2, only a portion of the cross section is shown, and where is line 5-5 in Figure 4? Figures 3-4 are inconsistent with the description at page 15, paragraph starting at line 18 because elastics are specifically illustrated in lateral sections. In Figure 1, the lines from 74, 78 and 52 should be dashed to denote underlying structure. Also 92 should be 94. In Figures 3 and 4, 52 should be 74 and the line therefrom should be dashed to denote underlying structure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The formal drawings filed 5-28-2002 have been placed in the application. Approval thereof is held in abeyance until all drawing informalities have been overcome.

8. The use of the trademarks on pages 14 and 21 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trade marks should be shown with either all capital letters or a trademark symbol, not both, without quotation marks and accompanied by generic terminology, but not the word "type" or "brand".

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9. It is noted that the terminology "user" on page 12, line 23 is interpreted to mean, user, caregiver or manufacturer.

10. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention Section, i.e a description of the claimed invention, and the invention of the claims are not commensurate, see MPEP 608.01(d) and 1302.01. 2) As discussed supra, the Figures and description are inconsistent. 3) The terminology on page 25 should be avoided because the specification should be limited to a discussion of the structure of the invention and the terminology deals with legal interpretation which is decided by the courts and legislature not through prosecution.

Appropriate correction is required.

11. Claims 1-5 and 8-12 are objected to because of the following informalities: In claim 8, line 6, "one or more" should be --at least one--, line 7, "sites" should be --site--, line 15, "site" should be --sites-- and on line 16, "that such" should be --such that said--. Claims 1-5, 9-12, and 21, line 1, "A" should be --The--. In claims 1 and 21, lines 1-2 seem to missing a word or words, i.e. line 1, after "8," or "1," resp., --wherein-- should be inserted and on line 2, "being" should be --is--. In claims 2 and 9, line 2, "respective" should be deleted. In claims 4 and 11, lines 2 and 3, resp., "employment of" should be deleted. Appropriate correction is required.

12. Claims 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 2 and 9 are redundant.

13. Applicant is advised that should claim 2 or 9 be found allowable, claim 9 or 2, resp., will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-5, 8-12 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Romare.

See abstract, Figures, col. 1, line 57-col. 2, line 22, col. 2, lines 58-63, col. 3., line 21-col. 4, line 21, col. 4, lines 29-66, col. 5, lines 6-53, i.e. lateral sections are 13, 14, inner portion fastening, 15-17, outer portion fastening, 10, 110, back portion/outer portion fastening, col. 3, lines 58-65, strength of attachments, e.g., col. 3, line 66-col. 4, line 62, col. 5, lines 14-33. While the Romare patent is believed to explicitly set forth the strength of attachments, even if not, since the structure of the securements and fastenings of Romare is the same as that claimed, the capabilities and functions of such claimed structure is deemed inherent also in the same structure of Romare, see MPEP 2012.01.

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16. Claims 1-5, 8-12, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by McNichols, '805.

See Figures 2-5, claims, especially 6-7 and 10, col. 5, lines 6-11, col. 7, line 11-col. 8, line 43, col. 6, lines 13-25, 32-50 and 62-66, col. 10, lines 27-35, i.e. lateral sections are side panels 28, inner portion fastenings are primary fasteners, outer portion fastenings are releasable bonds, back portion/outer portion fastening, see claim 4, strength of attachments, see claim 14 and col. 14, line 50-col. 16, line 45. Again, while the McNichols patent is believed to explicitly set forth the strength of attachments, even if not, since the structure of the securements and fastenings of McNichols is the same as that claimed, the capabilities and functions of such claimed structure is deemed inherent also in the same structure of McNichols, see MPEP 2112.01.

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-5, 8-12 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,036,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the effective filing date of the instant application is after that of the patent, the one way In re Vogel test applies, i.e. are the application claims in the instant application obvious in view of the patent claims? The answer is yes because the product produced during the method as claimed or end product of the method as claimed in the patent claims is obviously a product as claimed in the claims of the instant application.

19. Claims 1-5, 8-12 and 21 are directed to an invention not patentably distinct from claims 1-25 of commonly assigned 6,036, 805. Specifically, see preceding obvious double patenting rejection of the claims.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 6,036,805, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the

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invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references also teach various claimed features.

21. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number (703)308-2617. The Examiner's regular work schedule is Monday-Thursday.

KMR

September 24, 2002

K.M. Reichle
Patent Examiner